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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/147,405	04/01/1999	BENGT GUSS	REF/GUSS/P33	1676

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EXAMINER

DEVI, SARVAMANGALA J N

ART UNIT	PAPER NUMBER
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1645

DATE MAILED: 08/12/2003

35

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/147,405

Applicant(s)
Guss et al.

Examiner
S. Devi, Ph.D.

Art Unit
1645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jul 9, 2003
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above, claim(s) 2-24 and 26-29 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1, 25, and 30 is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 07/09/03 is: a) ☐ approved b) ☒ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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RESPONSE TO APPLICANTS' AMENDMENT

Applicants' Amendment

1) Acknowledgment is made of Applicants' amendment filed 07/09/03 (paper no. 34) in response to the non-final Office Action mailed 04/09/03 (paper no. 33). With this, Applicants have amended the specification.

Status of Claims

2) Claims 1, 25 and 30 have been amended via the amendment filed 07/09/03.
Claims 1-30 are pending.
Claims 1, 25 and 30 are under examination.

Prior Citation of Title 35 Sections

3) The text of those sections of Title 35 U.S. Code not included in this action can be found in a prior Office Action.

Prior Citation of References

4) The references cited or used as prior art in support of one or more rejections in the instant Office Action and not included on an attached form PTO-892 or form PTO-1449 have been previously cited and made of record.

Objection(s) Withdrawn

5) The objection to the specification made in paragraph 7 of the Office Action mailed 04/09/03 (paper no. 33) is withdrawn in light of Applicants' amendments to the specification.
6) The objection to the drawings made in paragraph 2 of the Office Action mailed 05/09/00 (paper no. 13) under 37 C.F.R. 1.84 is withdrawn in light of the formal drawings filed 07/09/03.

Rejection(s) Withdrawn

7) The rejection of claims 1, 25 and 30 made in paragraph 19 of the Office Action mailed 04/09/03 (paper no. 33) under 35 U.S.C. § 101 as being directed to a non-statutory subject matter is withdrawn in light of Applicants' amendment to the base claim.
8) The rejection of 25 and 30 made in paragraph 20 of the Office Action mailed 04/09/03 (paper no. 33) under 35 U.S.C. § 112, second paragraph, as being indefinite, is withdrawn in light of Applicants' amendments to the claims.

Specification

9) The instant specification is objected to for the following reason:

The specification at line 2 on page, as amended via the amendment filed 07/09/03, deletes the specific amino acid sequence 'LPXTG' and thereby broadens the scope of the sentence by replacing the sequence with a much broader limitation: '5 amino acid' motif. The sentence states that the motif involved in cell wall anchoring is indicated in 'bold characters' in Figures 6A-6E. However, an examination of Figure 6A-6E both by the Examiner of record and the Office's Draftsperson has led to the conclusion that Figure 6 does not discernibly highlight or show in 'bold characters' a 5 amino acid motif. Figure 6A-6E is therefore objected to by the Examiner for not highlighting the specific 5 amino acid-long motif in a notable way such that when the patent resulting from the instant application gets published, one reading the patent would be able to readily identify the bold characters in Figure 6A-6E.

To obviate this objection, it is suggested that Applicants either retain the 'LPXTG' limitation and sequence comply as required under 37 C.F.R 1.821 through 1.825, or amend Figure 6A-6E by highlighting the specific '5 amino acid motif' in Figure 6A-6E in such notable way that one could differentiate the bold characters from the rest of the non-bold characters in the Figure.

New Rejection(s)

Applicants are asked to note the following new rejection(s) made in this Office Action. The new rejections and/or objections are necessitated by Applicants' amendments to the claims and/or the specification.

Specification - New Matter

10) The amendment filed 07/09/03 is objected to under 35 U.S.C. § 132, because it introduces new matter into the disclosure. 35 U.S.C. § 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows. On page 10 of the specification, the paragraph beginning at page 6 deletes the limitation of the specific amino acid sequence 'LPDTG' and amends the sentence to include the much broader generic limitation '5 amino acid' motif. The former limitation of narrower scope 'LPDTG' is replaced with a much broader limitation. There is no descriptive support for the current generic limitation '5 amino acid' motif. The rest of the sentence states that the motif is followed by

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a stretch of 17 hydrophobic aa ending in a stretch of charged aa as shown in Figure 6. However, there are more than 17 amino acids at the C-terminal portion of the amino acid sequence as depicted in Figure 6A-6E, and since the hydrophobic and charged amino acids are not identified in any notable way, one cannot recognize which 5 amino acids out of these more than 17 amino acid residues constitute the C-terminal '5 amino acid' motif, given the current deletion of 'LPDTG'.

Applicants are required to cancel the new matter in the response to this Office Action.

Applicants' Remarks on Non-elected Claims

11) Applicants submit that the Office should reopen prosecution on the non-elected claims 2-24 and 26-29, which were withdrawn from consideration due to a previous lack of unity. Applicants contend that there is no longer any prior art on claims 1 and 25 and that the special technical feature does define a contribution over the prior art. Applicants submit that claims 14-19, 24, 27 and 29 depend from claim 1 and thereby include all of the limitations of claim 1 including the technical feature which defines a contribution over the prior art. Applicants further state that because the DNA of claim 9 encodes the polypeptide of claim 1, claims 9 and 11 also include the technical feature that defines a contribution over the prior art.

Applicants' remarks have been noted. As explained by the previous Examiner on page 2 of the Office Action mailed 05/09/00, the elected claims, as amended, included a new special technical feature and were prosecuted on the merits; and Applicants did receive actions on the merits for the claims as they were presented. As clearly set forth on pages 4-6 of the previous Examiner's Office Action mailed 12/6/99 (paper no. 9), the invention groups that included claims 2-12, 14-19, 24, 27 and 29 lacked *the same or corresponding special technical feature* with invention I, and were therefore placed under separate groups. These claims still lack the same or corresponding special technical feature, because the special technical feature of Invention I is a protein or a polypeptide which does not share a common structure with the special technical features of the rest of the inventions, II through IX, i.e., a DNA; the use of protein for different purposes; the use of a gene; antibodies; the use of the DNA; and the use of the antibodies for different purposes. The protein or parts thereof; the DNA and the antibodies do not share a common structure. Claim 24 includes parts of a protein which is not indicated to be allowable and/or which does not define over the prior art. Claim 27 is drawn to a method of use of the product of invention I. Although claim 27 depends from

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and includes the limitations of claim 1, currently, the claim does not meet all criteria for patentability including the requirements of 35 U.S.C. § 112, second paragraph. Claim 27 would be rejoined with the allowable claim 1 if Applicants amend the claim as shown below:

--Claim 27 (Currently amended): A method of active immunization comprising the administration of the protein according to claim 1 to a mammal.--

Remarks

12) Claims 1, 25 and 30 are allowable over the prior art of record.

This application contains claims drawn to non-elected inventions. A complete response to the final rejection must include cancellation of non-elected claims or other appropriate action (37 CFR 1.144). MPEP § 821.01.

13) Applicants' amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 C.F.R. 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

14) Papers related to this application may be submitted to Group 1600, AU 1645 by facsimile transmission. Papers should be transmitted via the PTO Fax Center located in Crystal Mall 1. The transmission of such papers by facsimile must conform with the notice published in the Official Gazette, 1096 OG 30, November 15, 1989. The CM1 facsimile center receives papers 24 hours a day, seven days a week. The RightFax number for submission of before-final amendments is (703) 872-9306. The RightFax number for submission of after-final amendments is (703) 872-9307.

15) Any inquiry concerning this communication or earlier communications from the Examiner should be directed to S. Devi, Ph.D., whose telephone number is (703) 308-9347. A message may be left on the Examiner's voice mail system. The Examiner can normally be reached on Monday to

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Friday from 7:45 a.m to 4.15 p.m. except one day each bi-week, which would be disclosed on the Examiner's voice mail system.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Lynette Smith, can be reached on (703) 308-3909.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

August, 2003


S. DEVI, PH.D.
PRIMARY EXAMINER